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KENNETH E. MACKLIN
MILDE, HOFFBERG & MACKLIN
10 BANK STREET
SUITE 460
WHITE PLAINS NY 10606

COPY MAILED

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OFFICE OF PETITIONS

In re Application of
Karsten Brauer, Frank Gansicke, Helmut
Friedrich, and Heinz Fabian
Application No. 08/897,713
Filed: July 21, 1997
Attorney Docket No.: HQ202
Title: PROCESS AND APPARATUS FOR
THE PRODUCTION OF A CYLINDRICAL
COMPONENT OF GLASS

DECISION ON THIRD
RENEWED PETITION AND
PETITION UNDER 37 C.F.R. §1.137(b)

This is a decision on the third renewed petition under 37 CFR §1.137(a)¹ to revive the above-identified application, as well as a petition under 37 C.F.R. §1.137(b), both filed together on July 16, 2003.

On August 31, 1998, the Office mailed a non-final Office Action to petitioner. On December 4, 1998, a reply was received. On March 18, 1999, a letter was mailed to the applicant, indicating that the reply was non-responsive, and giving the applicant one (1) month to reply. On April 22, 1999, an amendment was received which contained a certificate of mailing dated April 19, 1999. Again, this amendment was non-responsive, and on June 15, 1999, another letter was mailed to the applicant, indicating that this third attempt was non-responsive, and again giving the applicant one (1) month to reply. The above-identified application became abandoned for failure to reply in a timely manner to this letter of June 15, 1999. No response was received, and no extensions of time under the provisions of 37 C.F.R. §1.136(a) were requested. Accordingly, the

¹ A grantable petition pursuant to 37 CFR 1.137(a) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(l);
- (3) A showing to the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unavoidable;
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

above-identified application became abandoned on July 16, 1999. A Notice of Abandonment was mailed on October 1, 1999.

On January 6, 2002, petitioner filed the original petition, which was dismissed via a decision mailed on March 11, 2003, for failure to establish that the delay was unavoidable.

On April 1, 2003, petitioner filed the renewed petition, along with a petition under 37 C.F.R. §1.181(a). Both were dismissed via a decision mailed on May 13, 2003: the former for failing to establish that the delay was unavoidable, and the later for a lack of timeliness.

The third renewed petition under 37 C.F.R. §1.137(a)

Concerning the third renewed petition under 37 C.F.R. §1.137(a), the petition is **DISMISSED**. The third renewed petition lacks item (3) above.

As to item (3), the showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 37 CFR 1.137(a).

The Commissioner is responsible for determining the standard for unavoidable delay and for applying that standard.

"In the specialized field of patent law, . . . the Commissioner of Patent and Trademarks is primarily responsible for the application and enforcement of the various narrow and technical statutory and regulatory provisions. The Commissioner's interpretation of those provisions is entitled to considerable deference."²

"[T]he Commissioner's discretion cannot remain wholly uncontrolled, if the facts clearly demonstrate that the applicant's delay in prosecuting the application was unavoidable, and that the Commissioner's adverse determination lacked any basis in reason or common sense."³

"The court's review of a Commissioner's decision is 'limited, however, to a determination of whether the agency finding was arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with the law.'"⁴

"The scope of review under the arbitrary and capricious standard is narrow and a court is not to substitute its judgment for that of the agency."⁵

² Rydeen v. Quigg, 748 F.Supp. 900, 904, 16 U.S.P.Q.2d (BNA) 1876 (D.D.C. 1990), aff'd without opinion (Rule 36), 937 F.2d 623 (Fed. Cir.1991) (citing Morganroth v. Quigg, 885 F.2d 843, 848, 12 U.S.P.Q.2d (BNA) 1125 (Fed. Cir. 1989); Ethicon, Inc. v. Quigg 849 F.2d 1422, 7 U.S.P.Q.2d (BNA) 1152 (Fed. Cir. 1988) ("an agency's interpretation of a statute it administers is entitled to deference"); see also Chevron U.S.A. Inc. v. Natural Resources Defence Council, Inc., 467 U.S. 837, 844, 81 L. Ed. 694, 104 S. Ct. 2778 (1984) ("if the statute is silent or ambiguous with respect to the specific issue, the question for the court is whether the agency's answer is based on a permissible construction of the statute.")

³ Commissariat A L'Energie Atomique et al. v. Watson, 274 F.2d 594, 597, 124 U.S.P.Q. (BNA) 126 (D.C. Cir. 1960) (emphasis added).

⁴ Haines v. Quigg, 673 F. Supp. 314, 316, 5 U.S.P.Q.2d (BNA) 1130 (N.D. Ind. 1987) (citing Camp v. Pitts, 411 U.S. 138, 93 S. Ct.1241, 1244 (1973) (citing 5 U.S.C. 706 (2)(A)); Beerly v. Dept. of Treasury, 768 F.2d 942, 945 (7th Cir. 1985); Smith v. Mossinghoff, 217 U.S. App. D.C. 27, 671 F.2d 533, 538 (D.C. Cir.1982)).

The standard

"[T]he question of whether an applicant's delay in prosecuting an application was unavoidable must be decided on a case-by-case basis, taking all of the facts and circumstances into account."⁶

The general question asked by the Office is: "Did petitioner act as a reasonable and prudent person in relation to his most important business?"⁷

Nonawareness of a PTO rule will not constitute unavoidable delay⁸

The burden of showing the cause of the delay is on the person seeking to revive the application⁹.

A delay caused by an applicant's lack of knowledge or improper application of the patent statute, rules of practice, or the MPEP is not rendered "unavoidable" due to either the applicant's reliance upon oral advice from USPTO employees or the USPTO's failure to advise the applicant to take corrective action¹⁰.

The Office must rely on the actions or inactions of duly authorized and voluntarily chosen representatives of the applicant, and the applicant is bound by the consequences of those actions or inactions¹¹. Specifically, petitioner's delay caused by the mistakes of negligence of his voluntarily chosen representative does not constitute unavoidable delay within the meaning of 35 USC 133¹².

The actions of the attorney are imputed to the client, for when a petitioner voluntarily chooses an attorney to represent him, the petitioner cannot later distance avoid the repercussions of the actions or inactions of this selected representative, for clients are bound by the acts of their lawyers/agents, and

⁵ Ray v. Lehman, 55 F.3d 606, 608, 34 U.S.P.Q.2d (BNA) 1786 (Fed. Cir. 1995) (citing Motor Vehicles Mfrs. Ass'n v. State Farm Mut. Auto. Ins. Co., 463 U.S. 29, 43, 77 L.Ed.2d 443, 103 S. Ct. 2856 (1983)).

⁶ Id.

⁷ See In re Mattulah, 38 App. D.C. 497 (D.C. Cir. 1912).

⁸ See Smith v. Mossinghoff, 671 F.2d 533, 538, 213 U.S.P.Q. (BNA) 977 (Fed. Cir. 1982) (citing Potter v. Dann, 201 U.S.P.Q. (BNA) 574 (D.D.C. 1978) for the proposition that counsel's nonawareness of PTO rules does not constitute "unavoidable" delay)). Although court decisions have only addressed the issue of lack of knowledge of an attorney, there is no reason to expect a different result due to lack of knowledge on the part of a pro se (one who prosecutes on his own) applicant. It would be inequitable for a court to determine that a client who spends his hard earned money on an attorney who happens not to know a specific rule should be held to a higher standard than a pro se applicant who makes (or is forced to make) the decision to file the application without the assistance of counsel.

⁹ Id.

¹⁰ See In re Sivertz, 227 USPQ 255, 256 (Comm'r Pat. 1985).

¹¹ Link v. Wabash, 370 U.S. 626, 633-634 (1962).

¹² Haines, 673 F.Supp. at 316-17, 5 U.S.P.Q.2d at 1131-32; Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 103, 131 (Comm'r Pat. 1891).

constructively possess "notice of all facts, notice of which can be charged upon the attorney"¹³.

"Courts hesitate to punish a client for its lawyer's gross negligence, especially when the lawyer affirmatively misled the client," but "if the client freely chooses counsel, it should be bound to counsel's actions"¹⁴.

The portion of the MPEP relevant to the abandonment of this application

MPEP 711.03(c) states, in part:

PETITION TO WITHDRAW HOLDING OF ABANDONMENT BASED ON FAILURE TO RECEIVE OFFICE ACTION

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of *Delgar* is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

Two additional procedures are available for reviving an application that has become abandoned due to a failure to reply to an Office Action: (1) a petition under 37 CFR 1.137(a) based upon unavoidable delay; and (2) a petition under 37 CFR 1.137(b) based on unintentional delay.

§ 1.121 Manner of making amendments in application.

(c) Claims. —

- (1) Amendment by rewriting, directions to cancel or add. Amendments to a claim must be made by rewriting such claim with all changes (e.g., additions, deletions, modifications) included. The rewriting of a claim (with the same number) will be construed as directing the

¹³ *Link* at 633-634.

¹⁴ *Inryco, Inc. v. Metropolitan Engineering Co., Inc.*, 708 F.2d 1225, 1233 (7th Cir. 1983). See also, *Wei v. State of Hawaii*, 763 F.2d 370, 372 (9th Cir. 1985); *LeBlanc v. I.N.S.*, 715 F.2d 685, 694 (1st Cir. 1983).

cancellation of the previous version of that claim. A claim may also be canceled by an instruction.

- (i) A rewritten or newly added claim must be in clean form, that is, without markings to indicate the changes that have been made. A parenthetical expression should follow the claim number indicating the status of the claim as amended or newly added (e.g., "amended," "twice amended," or "new").
- (ii) If a claim is amended by rewriting such claim with the same number, the amendment must be accompanied by another version of the rewritten claim, on one or more pages separate from the amendment, marked up to show all the changes relative to the previous version of that claim. A parenthetical expression should follow the claim number indicating the status of the claim, e.g., "amended," "twice amended," etc. The parenthetical expression "amended," "twice amended," etc. should be the same for both the clean version of the claim under paragraph (c)(1)(i) of this section and the marked up version under this paragraph. The changes may be shown by brackets (for deleted matter) or underlining (for added matter), or by any equivalent marking system. A marked up version does not have to be supplied for an added claim or a canceled claim as it is sufficient to state that a particular claim has been added, or canceled.
- (2) A claim canceled by amendment (deleted in its entirety) may be reinstated only by a subsequent amendment presenting the claim as a new claim with a new claim number.
- (3) A clean version of the entire set of pending claims may be submitted in a single amendment paper. Such a submission shall be construed as directing the cancellation of all previous versions of any pending claims. A marked up version is required only for claims being changed by the current amendment (see paragraph (c)(1)(ii) of this section). Any claim not accompanied by a marked up version will constitute an assertion that it has not been changed relative to the immediate prior version.

Application of the standard to the current facts and circumstances

In both the original and the renewed petition, petitioner maintains that the circumstances that led to the abandonment of the application meet the aforementioned unavoidable standard and, therefore; petitioner qualifies for relief under 37 CFR 1.137(a). In support thereof, petitioner contends that this mailing was never received.

In the renewed petition, petitioner submitted what was described as a docket report, which did not contain information for the relevant time period. It was set forth that "a search has been conducted, and no such back-up or paper copy is known to exist. The firm has no formal policy on maintaining such sheets, especially from so long ago¹⁵."

On page 6 of the decision on the renewed petition, the following was set forth:

A docket report is a mail log, recorded by the person who receives all incoming mail. A docket report should show all incoming mail received during the relevant time period, in order to establish that the correspondence at issue was not received, and merely misplaced and filed with another file.

On page 7 of the decision on the renewed petition, the following was written:

First, the docket print-out is not a mail log. A mail log is a record of items received. Whether a response is due or has been submitted is irrelevant to a record that accurately reflects all correspondence received during a particular time period. As such, this listing is a "to-do" list rather than a mail log, and hence, even if the record showed all relevant dates, it would not be acceptable as a record of all incoming mail.

Secondly, if entries in the record are deleted after a response is sent or if it is determined that no response is due, this negates the record's ability to confirm that an article of mail was or was not received. Once a member of the office staff deletes an entry, the record would provide to a later observer a false indication that the article of mail was never received.

¹⁵ Renewed petition, page 5.

Petitioner also submitted copies of an index card system, which obviously was not determined to constitute a mail-log as each index card is associated with a particular file.

With the second renewed petition, Petitioner sets forth "it is noted that, in contrast to typical policies of the U.S. Patent and Trademark Office, no telephone call was apparently made to determine whether the abandonment was intentional¹⁶." Petitioner has not cited to any statute, rule, regulation, or portion of the MPEP which requires Examiners to extend this courtesy to applicants or provides a remedy or recourse to applicants should this situation arise.

Petitioner points out that the Examiner in charge of the application changed during prosecution, but it is not clear how this fact is germane to the abandonment of the instant application.

Petitioner states that the amendment "is not in a preferred format for amendments, not that it was inconsistent with the patent office rules. Thus, a review of the record, but for the missing correspondence, would not have revealed the status of the application¹⁷." 37 C.F.R. §1.121 sets forth the manner in which applicants must submit amendments. As such, the manner in which the applicant chose to submit his amendment was indeed inconsistent with patent office rules. Furthermore, an attorney who is registered to practice before the Office has a duty to keep himself up to date and aware of the rules and procedures under which this Office operates. An attorney or agent who meets this duty would have been aware of the inconsistent amendment, upon reviewing the file.

Petitioner again asserts that the index cards constitute a reliable mail log. Petitioner states that "the filing of correspondence is a separate step from, and independent of, the docketing of the correspondence. Misfiling of the correspondence would not affect, or change, the entries in the docket system¹⁸." As set forth in the previous decision, Petitioner's docketing system does not accurately reflect all correspondence received during a particular time period, and it cannot be relied upon to confirm whether an article of mail was or was not received, as entries can and are removed. For these reasons, petitioner's docket record is both incomplete¹⁹ and unreliable²⁰.

Petitioner then writes "Thus, in contrast to the Petitions Examiner's surmise (bottom of page 6 – top of page 7), the misfiling of the document would not affect the docket card entry²¹." To buttress his argument, petitioner has submitted copies of index cards from "related cases²²." Petitioner states that his index card entries are "distinct from a 'file wrapper maintained' docket entry²³." As was explained in both the decision on the original petition and the decision on the renewed petition,

A docket report is a mail log, recorded by the person who receives all incoming mail. A docket report should show all incoming mail received during the relevant time period, in order to

16 Second Renewed Petition, page 2.

17 Id.

18 Second Renewed Petition, page 3.

19 See Decision on Renewed Petition, page 6.

20 See Decision on Renewed Petition, page 7.

21 Second Renewed Petition, page 3.

22 Id.

23 Id.

establish that the correspondence at issue was not received, and merely misplaced and filed with another file.

Once again, petitioner's index cards do not constitute a mail log, since they do not show all mail that was received during a particular time period. All they show is the entries which were made that are particular to that application. If a paper was misfiled, it would not appear on the card, and it is plausible that the staff member who creates these cards placed the representative notation on the wrong card, if at all. It follows that the submission of index cards for other related cases is not convincing, as it is possible that the entry was made on a card other than one provided, or not at all.

As set forth above, it has been established that entries are at times removed from the electronic database. Petitioner has submitted declarations of fact from two employees of his firm who attest that they do not remember receiving the missing paper in 1999. Petitioner further states that it is "inconceivable that the docket entry was intentionally removed from the electronic database without a corresponding set of entries on the card, without the recollection of a person involved. Our staff recalls no such occurrence." It is plausible that an error was committed and an entry was removed from the electronic database without a corresponding entry on the index card. Furthermore, the PTO file is the official record of the papers originally filed in this application. A review of the official file reveals that the letter in question was mailed to the petitioner on June 15, 1999. An applicant alleging non-receipt of a paper has the burden of proving the allegation by a preponderance of the evidence. Petitioner has asserted that no member of his office remembers receiving a letter which was mailed to the firm on June 15, 1999. However, the memories of petitioner's staff and of the declarants of a routine mailing practice which occurred *over four years prior* is not more persuasive than the PTO file.

Petitioner next describes the Office's internal mail system, and surmises that the Office's "mail system is not infallible"²⁴. The Office acknowledges that the mail system can and does err. However, petitioner is reminded that the burden rests on him to establish that the delay was unavoidable²⁵.

The Petitioner next asserts that he his docketing system is sufficient to meet the standards of a reliable docketing system. This assertion is incorrect, due to the incompleteness and unreliability of the docketing system, as set forth above.

Finally, petitioner, underneath the heading "Public Policy", challenges the applicability of case law that has been well established for over one hundred years, without asserting that said case law has been overturned. Furthermore, the petitioner would have the Office decree that punctuality, due diligence, and good faith are not essential requisites to the success of those who seek to obtain the special privileges of patent law, and each is unnecessary to the interest of the public and for the protection of rival inventors. The Office declines this invitation.

24 Second Renewed Petition, page 7.

25 MPEP 711.03(c)III(F).

The petition under 37 C.F.R. §1.137(b)

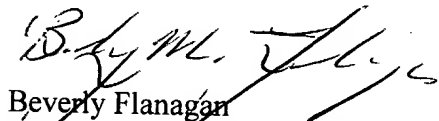
Regarding the petition under 37 C.F.R. §1.137(b), subsection (3) of this section of the C.F.R. requires a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 C.F.R. §1.137(b) was unintentional. Since the statement contained in the instant petition varies from the language required by 37 C.F.R. §1.137(b)(3), the statement contained in the instant petition is being construed as the statement required by 37 C.F.R. §1.137(b)(3) and petitioner must notify the Office if this is not a correct interpretation of the statement contained in the instant petition.

The petitioner has met the requirements to revive the above-identified application, pursuant to 37 CFR 1.137(b). Petitioner submitted the required reply in the form of the submission of an amendment, payment of the petition fee, and a statement which is being construed as the proper statement of unintentional delay. It is noted that substitute drawings were received in the Office on November 25, 2002.

Consequently, the petition is **GRANTED**.

The application file is being forwarded to Technology Center 1700 for further processing.

Telephone inquiries concerning this decision should be directed to Attorney Paul Shanowski at (703) 305-0011.



Beverly Flanagan
Supervisory Petitions Examiner
Office of Petitions
United States Patent and Trademark Office